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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,860	02/11/2004	Wing Sum Vincent Kwan	29617/PM480A	3897
4743 7590 05/17/2007 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER SHOSHO, CALLIE E	
			ART UNIT 1714	PAPER NUMBER
			MAIL DATE 05/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/776,860

Applicant(s)

KWAN ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/26/07 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 10, 12-15, and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 549145.

EP 549145 discloses color changing paint composition comprising water, less than about 20% titanium dioxide, binder that is aqueous emulsion polymer, i.e. latex, that includes acrylic (co)polymer and ethylene-vinyl acetate, pH indicator including cresol red, phenolphthalein, and thymolphthalein, volatile acid or volatile base such as ammonia, and coalescent. Given that EP 549145 discloses binder identical to that presently claimed, it is clear that the binder is inherently film-forming as presently claimed. There is also disclosed method wherein the paint is applied to

substrate of similar color to conceal the features of the substrate on which it is painted. It is further disclosed that upon drying the paint changes color from non-white to white. Given that it is disclosed that the paint has good hiding power and hides or obscures the surface of the substrate in order to conceal the features of the substrate on which it is applied, it is clear that the paint would inherently correct any "errors", i.e. mark, scratches, etc. on the substrate by covering them (page 2, lines 1-4, 32-38, and 43-52, page 2, line 54-page 3, line 8, page 3, lines 14-15, 17-21, 25-26, 30, 32-37, and 48-50, col.3, line 55-col.4, line 9).

While there is no disclosure that the color changing composition of EP 549145 is a correction fluid as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. correction fluid, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art fluid and further that the prior art structure which is a color

changing composition identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

In light of the above, it is clear that EP 549145 anticipates the present claims.

4. Claims 23-24 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 549145.

EP 549145 discloses color changing paint composition comprising water, less than about 20% titanium dioxide, binder that is aqueous emulsion polymer, i.e. latex, that includes acrylic (co)polymer and ethylene-vinyl acetate, pH indicator including cresol red, phenolphthalein, and thymolphthalein, volatile acid or volatile base such as ammonia, and coalescent. Given that EP 549145 discloses binder identical to that presently claimed, it is clear that the binder is inherently film-forming as presently claimed (page 2, lines 1-4, 32-38, and 43-52, page 2, line 54-page 3, line 8, page 3, lines 14-15, 17-21, 25-26, 30, 32-37, and 48-50, col.3, line 55-col.4, line 9).

In light of the above, it is clear that EP 549145 anticipates the present claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
7. Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 549145 in view of Arendt (U.S. 5,236,987).

The disclosure with respect to EP 549145 in paragraph 3 above is incorporated here by reference.

The difference between EP 549145 and the present claimed invention is the requirement in the claims of specific coalescent.

Arendt, which is drawn to paint composition, disclose the use of isodecyl benzoate coalescent in order to produce composition with proper film formation that is stable over wide range of temperatures (col.1, lines 12-49, col.2, lines 3-4, and col.14, lines 22-25).

In light of the motivation for using specific coalescent disclosed by Arendt as described above, it therefore would have been obvious to one of ordinary skill in the art to utilize isodecyl benzoate in EP 549145 in order to produce stable composition with good film-forming properties, and thereby arrive at the claimed invention.

8. Claims 8-9 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 549145 in view of either Grouke et al. (U.S. 4,243,417) or Carroll et al. (U.S. 4,283,320).

The disclosure with respect to EP 549145 in paragraph 3 above is incorporated here by reference.

The difference between EP 549145 and the present claimed invention is the requirement in the claims of extender pigment.

Grouke et al., which is drawn to paint composition, disclose the use of extender pigment including calcium carbonate, aluminum silicate, and magnesium silicate in combination with white pigment such as titanium dioxide in order to inexpensively produce composition with desired pigment volume concentration (col.5, lines 59-60 and col.5, line 67-col.6, lines 15).

Alternatively, Carroll et al., which is drawn to paint composition, disclose the use of calcium carbonate extender pigment in order to give body and thickness to the composition (col.5, lines 32-39).

In light of the motivation for using extender pigment disclosed by Grouke et al. or Carroll et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to utilize such extender pigment in EP 549145 in order to inexpensively produce composition with desired total pigment volume concentration or alternatively, with effective body and thickness, and thereby arrive at the claimed invention.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 549145 in view of Detrick et al. (U.S. 5,418,013).

The disclosure with respect to EP 549145 in paragraph 3 above is incorporated here by reference.

The difference between EP 549145 and the present claimed invention is the requirement in the claim of specific volatile acid.

EP 549145 discloses the use of volatile acid in combination with the pH indicator, however, there is no disclosure of the specific volatile acid utilized.

Detrick et al., which is drawn to coating composition, disclose the use of pH indicator that changes color upon change in pH wherein the pH of the composition is adjusted using volatile acid such as acetic acid (col.3, lines 31-37 and 47-60).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use acetic acid as the volatile acid in EP 549145 in order to produce composition with desired color, and thereby arrive at the claimed invention.

10. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 549145.

EP 549145 discloses color changing paint composition comprising water, less than about 20% titanium dioxide, binder that is aqueous emulsion polymer, i.e. latex, that includes acrylic (co)polymer and ethylene-vinyl acetate, pH indicator including cresol red, phenolphthalein, and thymolphthalein, volatile acid or volatile base such as ammonia, and coalescent . Given that EP 549145 discloses binder identical to that presently claimed, it is clear that the binder is intrinsically film-forming as presently claimed (page 2, lines 1-4, 32-38, and 43-52, page 2, line 54-page 3, line 8, page 3, lines 14-15, 17-21, 25-26, 30, 32-37, and 48-50, col.3, line 55-col.4, line 9).

The only deficiency of EP 549145 is that EP 549145 discloses the use of less than about 20% titanium oxide while the present claims require about 20% titanium dioxide.

It is apparent, however, that the instantly claimed amount of titanium dioxide and that taught by EP 549145 are so close to each other that the fact pattern is similar to the one in *In re Woodruff*, 919 F.2d 1575, USPQ2d 1934 (Fed. Cir. 1990) or *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed.Cir. 1985) where despite a “slight” difference in the ranges the court held that such a difference did not “render the claims patentable” or, alternatively, that “a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough so that one skilled in the art would have expected them to have the same properties”.

In light of the case law cited above and given that there is only a “slight” difference between the amount of titanium dioxide disclosed by EP 549145 and the amount disclosed in the present claims, it therefore would have been obvious to one of ordinary skill in the art that the amount of titanium dioxide disclosed in the present claims is but an obvious variant of the

amount disclosed in EP 549145, and thereby one of ordinary skill in the art would have arrived at the claimed invention.

11. Claims 1-6, 10, 12-15, and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 549145.

EP 549145 discloses color changing paint composition comprising water, less than about 20% titanium dioxide, binder that is aqueous emulsion polymer, i.e. latex, that includes acrylic (co)polymer and ethylene-vinyl acetate, pH indicator including cresol red, phenolphthalein, and thymolphthalein, volatile acid or volatile base such as ammonia, and coalescent. Given that EP 549145 discloses binder identical to that presently claimed, it is clear that the binder is intrinsically film forming as presently claimed. There is also disclosed method wherein the paint is applied to substrate of similar color to conceal the features of the substrate on which it is painted. It is further disclosed that upon drying the paint changes color from non-white to white. Given that it is disclosed that the paint has good hiding power and hides or obscures the surface of the substrate in order to conceal the features of the substrate on which it is applied, it is clear that the paint would intrinsically correct any "errors", i.e. mark, scratches, etc. on the substrate by covering them (page 2, lines 1-4, 32-38, and 43-52, page 2, line 54-page 3, line 8, page 3, lines 14-15, 17-21, 25-26, 30, 32-37, and 48-50, col.3, line 55-col.4, line 9).

The difference between EP 549145 and the present claimed invention is the requirement in the claims of (a) amount of titanium dioxide and (b) correction fluid.

With respect to difference (a), it is noted that EP 549145 discloses the use of less than about 20% titanium oxide while the present claims require about 20% titanium dioxide.

It is apparent, however, that the instantly claimed amount of titanium dioxide and that taught by EP 549145 are so close to each other that the fact pattern is similar to the one in *In re Woodruff*, 919 F.2d 1575, USPQ2d 1934 (Fed. Cir. 1990) or *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed.Cir. 1985) where despite a “slight” difference in the ranges the court held that such a difference did not “render the claims patentable” or, alternatively, that “a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough so that one skilled in the art would have expected them to have the same properties”.

In light of the case law cited above and given that there is only a “slight” difference between the amount of titanium dioxide disclosed by EP 549145 and the amount disclosed in the present claims, it therefore would have been obvious to one of ordinary skill in the art that the amount of titanium dioxide disclosed in the present claims is but an obvious variant of the amounts disclosed in EP 549145, and thereby one of ordinary skill in the art would have arrived at the claimed invention.

With respect to difference (b), while there is no disclosure that the color changing composition of EP 549145 is a correction fluid as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that “if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction”. Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the

purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. correction fluid, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art fluid and further that the prior art structure which is a color changing fluid identical to that set forth in the present claims is capable of performing the recited purpose or intended use, and thus, one of ordinary skill in the art would have arrived at the claimed invention.

12. Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 549145 as applied to claims 1-6, 10, 12-15, and 19-22 above, and further in view of Arendt (U.S. 5,236,987).

The difference between EP 549145 and the present claimed invention is the requirement in the claims of specific coalescent.

Arendt, which is drawn to paint composition, disclose the use of isodecyl benzoate coalescent in order to produce composition with proper film formation that is stable over wide range of temperatures (col.1, lines 12-49, col.2, lines 3-4, and col.14, lines 22-25).

In light of the motivation for using specific coalescent disclosed by Arendt as described above, it therefore would have been obvious to one of ordinary skill in the art to utilize isodecyl

benzoate in EP 549145 in order to produce stable composition with good film-forming properties, and thereby arrive at the claimed invention.

13. Claims 8-9 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 549145 as applied to claims 1-6, 10, 12-15, and 19-22 above, and further in view of either Grouke et al. (U.S. 4,243,417) or Carroll et al. (U.S. 4,283,320).

The difference between EP 549145 and the present claimed invention is the requirement in the claims of extender pigment.

Grouke et al., which is drawn to paint composition, disclose the use of extender pigment including calcium carbonate, aluminum silicate, and magnesium silicate in combination with white pigment such as titanium dioxide in order to inexpensively produce composition with desired pigment volume concentration (col.5, lines 59-60 and col.5, line 67-col.6, lines 15).

Alternatively, Carroll et al., which is drawn to paint composition, disclose the use of calcium carbonate extender pigment in order to give body and thickness to the composition (col.5, lines 32-39).

In light of the motivation for using extender pigment disclosed by Grouke et al. or Carroll et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to utilize such extender pigment in EP 549145 in order to inexpensively produce composition with desired total pigment volume concentration or alternatively, with effective body and thickness, and thereby arrive at the claimed invention.

14. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 549145 as applied to claims 1-6, 10, 12-15, and 19-22 above, and further in view of Detrick et al. (U.S. 5,418,013).

The difference between EP 549145 and the present claimed invention is the requirement in the claim of specific volatile acid.

EP 549145 discloses the use of volatile acid in combination with the pH indicator, however, there is no disclosure of the specific volatile acid utilized.

Detrick et al., which is drawn to coating composition, disclose the use of pH indicator that changes color upon change in pH wherein the pH of the composition is adjusted using volatile acid such as acetic acid (col.3, lines 31-37 and 47-60).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use acetic acid as the volatile acid in EP 549145 in order to produce composition with desired color, and thereby arrive at the claimed invention.

15. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Detrick et al. (U.S. 5,418,013) in view of Elfring et al. (U.S. 2002/0103283).

Detrick et al. disclose color changing fluid comprising water, titanium dioxide, binder that is aqueous emulsion polymer, i.e. latex, that includes acrylic latex and styrene-acrylic latex, pH indicator including cresol red, phenolphthalein, and thymolphthalein, volatile acid such as acetic acid or volatile base such as ammonia, and coalescent. Given that Detrick et al. disclose binder identical to that presently claimed, it is clear that the binder is intrinsically film forming as

presently claimed (col.1, lines 37-52, col.2, lines 20-25, 29-35, 43, 47-50, and 54-61, and col.3, lines 25-60).

The difference between Detrick et al. and the present claimed invention is the requirement in the claims of the amount of titanium dioxide.

There is no explicit disclosure in Detrick et al. of the amount of titanium dioxide utilized with the exception of the examples that utilize amounts outside the scope of the present claims. However, these are just a few preferred embodiments of Detrick et al. It is noted that “nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims”, *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). A fair reading of Detrick et al. as a whole discloses that there is no limit regarding the amount of titanium dioxide utilized.

Elfring et al., which is drawn to roof coating as is Detrick et al., disclose the use of 10-90% titanium dioxide in order to impart aesthetic and functional qualities to the coating and disclose that the amount of titanium dioxide depends on the consistency of coating desired, presence or absence of thickening agents, amount and identity of solvent utilized, etc. (paragraphs 1-2 and 39-40).

In light of the motivation of using specific amount of titanium dioxide disclosed by Elfring et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to utilize amount of titanium dioxide, including that presently claimed, in Detrick et al. in order to produce color changing fluid with desired aesthetic and functional qualities as well as desired consistency, and thereby arrive at the claimed invention.

16. Claims 1-6 and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Detrick et al. (U.S. 5,418,013) in view of Elfring et al. (U.S. 2002/0103283).

Detrick et al. disclose color changing fluid comprising water, titanium dioxide, binder that is aqueous emulsion polymer, i.e. latex, that includes acrylic latex and styrene-acrylic latex, pH indicator including cresol red, phenolphthalein, and thymolphthalein, volatile acid such as acetic acid or volatile base such as ammonia, and coalescent. Given that Detrick et al. disclose binder identical to that presently claimed, it is clear that the binder is intrinsically film-forming as presently claimed (col.1, lines 37-52, col.2, lines 20-25, 29-35, 43, 47-50, and 54-61, and col.3, lines 25-60).

The difference between Detrick et al. and the present claimed invention is the requirement in the claims of (a) the amount of titanium dioxide and (b) correction fluid.

With respect to difference (a), it is noted that there is no explicit disclosure in Detrick et al. of the amount of titanium dioxide utilized with the exception of the examples that utilize amounts outside the scope of the present claims. However, these are just a few preferred embodiments of Detrick et al. It is noted that "nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims", *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). A fair reading of Detrick et al. as a whole discloses that there is no limit regarding the amount of titanium dioxide utilized.

Elfring et al., which is drawn to coating roof coating as is Detrick et al., disclose the use of 10-90% titanium dioxide in order to impart aesthetic and functional qualities to the coating and disclose that the amount of titanium dioxide depends on the consistency of coating desired,

presence or absence of thickening agents, amount and identity of solvent utilized, etc.
(paragraphs 1-2 and 39-40).

In light of the motivation of using specific amount of titanium dioxide disclosed by Elfring et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to utilize amount of titanium dioxide, including that presently claimed, in Detrick et al. in order to produce color changing fluid with desired aesthetic and functional qualities as well as desired consistency, and thereby arrive at the claimed invention.

With respect to difference (b), it is noted that there is no disclosure in Detrick et al. or Elfring et al. of correction fluid.

While there is no disclosure that the color changing fluid of Detrick et al. in combination with Elfring et al. is a correction fluid as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. correction

fluid, recited in the present claims does not result in a structural difference between the presently claimed invention and the fluid of Detrick et al. in combination with Elfring et al. and further that the fluid of Detrick et al. in combination with Elfring et al. which is a color changing fluid as presently claimed is capable of performing the recited purpose or intended use, and thus, one of ordinary skill in the art would have arrived at the claimed invention.

17. Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Detrick et al. in view of Elfring et al. as applied to claims 1-6 and 10-15 above, and further in view of Fasano et al. (U.S. 2002/0151648).

The difference between Detrick et al. in view of Elfring et al. and the present claimed invention is the requirement in the claims of specific coalescent.

Fasano et al., which is drawn to architectural coatings as is Detrick et al., disclose that frequently a VOC such as glycol ether is added to the coating to improve film properties or to aid in coatings application properties (paragraphs 5, 139, and 146).

In light of the motivation for using glycol ether disclosed by Fasano et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to utilize glycol ether in Detrick et al. in order to produce color changing fluid with good film forming and application properties, and thereby arrive at the claimed invention.

18. Claims 8-9 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Detrick et al. in view of Elfring et al. as applied to claims 1-6 and 10-15 above, and further in view of Schoenke (U.S. 4,032,491).

The difference between Detrick et al. in view of Elfring et al. and the present claimed invention is the requirement in the claims of extender pigment.


Schoenke, which is drawn to coating for roofs as is Detrick et al., discloses the use of extender pigment including calcium carbonate and magnesium silicate for cost reduction, fire retardant improvement, and film hardness improvement (col.8, lines 6-17).

In light of the motivation for using extender pigment disclosed by Schoenke as described above, it therefore would have been obvious to one of ordinary skill in the art to use such extender pigment in Detrick et al. in order to produce color changing fluid with reduced cost that has improved fire retardancy and film hardness, and thereby arrive at the claimed invention.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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